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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/611,724	07/01/2003	Gary F. Driscoll		6106
7590	08/06/2004		EXAMINER	
W. JOSEPH MELNIK PEPPER HAMILTON 500 GRANT STREET, 50TH FLOOR PITTSBURGH, PA 15219-2502				CHRISTMAN, KATHLEEN M
		ART UNIT	PAPER NUMBER	3713

DATE MAILED: 08/06/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.	Applicant(s)
10/611,724	DRISCOLL ET AL.
Examiner	Art Unit
Kathleen M Christman	3713

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) Responsive to communication(s) filed on 07/27/2004.
- 2a) This action is **FINAL**. 2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) Claim(s) 1-4 and 6-11 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) Claim(s) _____ is/are allowed.
- 6) Claim(s) 1-4 and 6-11 is/are rejected.
- 7) Claim(s) _____ is/are objected to.
- 8) Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on _____ is/are: a) accepted or b) objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) All b) Some * c) None of:
 1. Certified copies of the priority documents have been received.
 2. Certified copies of the priority documents have been received in Application No. _____.
 3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

<ol style="list-style-type: none"> 1)<input checked="" type="checkbox"/> Notice of References Cited (PTO-892) 2)<input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) 3)<input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date <u>08142003</u> 	<ol style="list-style-type: none"> 4)<input type="checkbox"/> Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ 5)<input type="checkbox"/> Notice of Informal Patent Application (PTO-152) 6)<input type="checkbox"/> Other: _____
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DETAILED ACTION

In response to the preliminary amendments filed 07/01/2003, 07/26/2004, and 07/27/2004. The amendment filed 07/27/2004 is a duplicate of the amendment filed 07/26/2004. The amendment has been entered into the application. The amendment dated 07/26/2004 states that claims 12-29 are withdrawn, however, these claims were cancelled in the preliminary amendment filed 07/01/2003. As such the claims remain cancelled. Claim 5 was cancelled by the amendment filed 07/26/2004. As such claims 5 and 12-29 are cancelled; claims 1-4 and 6-11 are pending.

Information Disclosure Statement

1. The information disclosure statement filed 08/14/2003 fails to comply with 37 CFR 1.98(a)(2), which requires a legible copy of each foreign patent; each publication or that portion which caused it to be listed; and all other information or that portion which caused it to be listed. Only the US patent listed has been considered.

Claim Rejections - 35 USC § 101

35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requires of this title.

2. Claims 1-4 and 6-11 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

The basis of this rejection is set forth in a two-prong test of:

- (1) whether the invention is within the technological arts; and
- (2) whether the invention produces a useful, concrete, and tangible result.

Technological Arts Analysis:

For a claimed invention to be statutory, the claimed invention must be within the technological arts. Mere ideas in the abstract (i.e., abstract idea, law of nature, natural phenomena) that do not apply, involve, use, or advance the technological arts fail to promote the "progress of science and the useful arts" (i.e., the physical sciences as opposed to social sciences, for example) and therefore are found to be non-statutory subject matter. For a process claim to pass muster, the recited process must somehow apply, involve, use, or advance the technological arts.

In the present case, the invention is within the technological arts. Claim 1 clearly recites that the test package is stored in a data store, which is known to be an electronic media type. Further the claim recites the use of a communication link used via a wide area network. These limitations clearly show the use of the technological arts. As claims 2-4 and 6-11 incorporate the technological features of claim 1 they are also within the technological arts.

Useful, Concrete and Tangible Analysis:

Additionally, for a claimed invention to be statutory, the claimed invention must produce a useful, concrete, and tangible result.

In the present case, the claims fail to produce a tangible result. In order for a result to be tangible it must be produce a real or actual effect, i.e. the effect must be appreciable. In the most generic terms claim 1 recites: a method including the steps of: storing a first data; establishing a communication link via a wide-area network; detecting if a second data stored at a remote site is outdated; and transmitting the first data to the remote site. The data is not viewed, altered, or otherwise manipulated at any point in the process. As such the method results in nothing more than the transmission of data over a communication network. This result is not appreciable, as one does see any real change or actual effect from the mere transmission of data. Claims 2-4 and 6-11 do not add an appreciable result to the method.

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

3. Claim 4 is rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention. The specification fails to define what constitutes an "enterprise service" as recited in the claims. The specification makes reference to programs such as "Java Enterprise Service" and "Enterprise JavaBeans", however, each of these references to specific programming applications and not to a generic enterprise service. A clear definition of this term is not described in the specification as originally filed.

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

4. Claim 4 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. The limitation of "an enterprise service" is unclear. The specification does not define the term, nor does the art offer a clear definition for the term. As such one of ordinary skill in the art cannot determine the metes and bounds of the claim and comparison of the claim to the prior art has been precluded.

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

5. Claims 1-3 and 6-9 rejected under 35 U.S.C. 103(a) as being unpatentable over Richard et al (US 6149438). Richard et al teaching a method of distributing course materials, which include tests (col. 13:42 - col. 14:11), where the method includes the steps of: storing a first version of a test package in a data store (the course version stored in the central repository 104); establishing a communication link with a test center (the communication link between the local server and the central repository, the LAN 120); detecting via said communication link, that a second version of the test package installed at said test center is out dated relative to said first version of said test package (the test to see if the current version is installed on the local sever, col. 5: 4-5); and transmitting said first version of said test package to said test center via said network (col. 5: 25-29), as in claim 1. A database f claim 3 is shown in figure 2.

Regarding claim 6, the detecting act including receiving a test center record indicative of test packages installed at said test center, said test center record indicating the presence or absence of one or more versions of said test package at said test center is taught in col. 5: 2-5; and determining, based on said test center record, that said first version of said test package is not installed (col. 5: 5, the step of the course not being found). Prior to the act of transmitting determining, according to a criterion, that said first version of said test package may be installed at said test center, as in claim 7, is taught in col. 4: 66, where the criterion is if the user has access to the course. Regarding claim 8, the "isVersionAllowed"

Art Unit: 3713

function which checks a version of software installed at said test center to determine whether an installation may proceed is taught in the functionality of col. 7: 12-18. This is shown in that the server must ensure that the version of the course the student is offered is the same as the one the student started taking the course with. As such the new version of the course will not be allowed on the server if the student needs a previous version. Regarding claim 9, updating a test center record at said test center to reflect installation of said first test version of said test package at said test center is shown in col. 5: 27,

Richard et al does not teach the use of a wide-area-network (WAN), as in claim 1; or that the WAN is the Internet (claim 2). The applicant has admitted that one of ordinary skill in the art recognizes that any LAN based system (such as Richard et al) may easily be modified to be WAN based system, the internet of which is the most common WAN and as such it would be obvious to one of ordinary skill in the art to modify the Richard et al system in this manner. The admission of such were made by applicant's failure to argue the old and well-known statements of the parent application 09/901797.

6. Claims 10 and 11 are rejected under 35 U.S.C. 103(a) as being unpatentable over Richard et al (US 6162060) in view of Cook et al (US 2002/0168621 A1).

Richard et al teaches all aspects of the claimed invention as shown above except packaging said test package in one or more data structures according to a first protocol and sending said one or more data structures to said first test center via said wide-area networking using a transport protocol different from said first protocol (claim 10) where the transport protocol is Hypertext Transport Protocol (HTTP). Cook et al teaches how encryption algorithms function in paragraphs 136-138. It is the examiner's position that this functionality is the same as that described by claim 10. Cook et al teaches the use of HTTP in paragraph 12. It would have been obvious to one of ordinary skill in the art to modify the Richard et al system with the encryption algorithms of Cook et al so as to provide a more secure data transmission of the testing data.

Conclusion

Art Unit: 3713

7. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

- a. Haff et al (US 6219669 B1 and US 2002/0184224A1) teaches a method for software transmission over a wide area network, including the Internet. Includes an automatic update feature
- b. Sonnenfeld (US 6112049) teaches a network based test distribution system
- c. Pellegrino et al (US 6149441) teaches a system and method for the networked distribution of course date

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Kathleen M Christman whose telephone number is (703) 308-6374. The examiner can normally be reached on M-F 7:30-5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Derris Banks can be reached on (703) 308-1745. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).


Kathleen M. Christman

JOHN M. HOTALING, II
PRIMARY EXAMINER

